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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,959	09/17/1999	KARL ERIK STAHL	927.1003	9455
21171	7590	05/17/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			DUONG, DUC T	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/397,959

Applicant(s)

STAHL, KARL ERIK

Examiner

Duc T. Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 4-6, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuster et al (U.S. Patent 6,674,745 B1).

Regarding to claims 1 and 4, Schuster discloses a telecommunication apparatus (fig. 4) for initiating and receiving voice and data comprising a first port (PSTN interface) to connect said apparatus to a PSTN network (fig. 2), a second port (IP network interface) to connect said apparatus to an IP network (fig. 2), and a gateway means (processor) for establishing a path between said first port and said second port inside

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said apparatus in response to a request from a server 40 on the IP network acting on behalf a caller (fig 4 col. 9 lines 49-58; noted the internet telephony device, operate in similar ways as ITG 30 in fig. 2, wherein a path is create between the PSTN interface and the IP network interface in response to a request to map a telephone number to an IP address from the AMS 40), whereby said telecommunication apparatus can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network and said packet based telecommunication network (fig. 4; the internet telephony system serve as a distributed gateway system connecting to both the PSTN and IP networks).

Regarding to claim 2, Schuster discloses a third port (handset interface) to connect a conventional telephone apparatus (handset) via said telecommunication apparatus to said first port (fig. 4 col. 12 lines 24-37).

Regarding to claim 5, Schuster discloses gateway location servers 40 connected to said IP network 19, said gateway location servers 40 being adapted to receive a request from a first telecommunication apparatus 18 connected to said packet IP network 19 for telecommunication with a specified telephone apparatus 14 on said PSTN network 24, and further being programmed to select a second of said telecommunication apparatuses 20 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus via IP network (fig. 1 col. 52-65).

Regarding to claim 6, Schuster discloses the packet based telecommunication network comprises the Internet (fig. 1 col. 4 lines 13-17).

Regarding to claim 8, Schuster discloses a telecommunication apparatus (fig. 4) for initiating and receiving voice and data comprising a first port (PSTN interface) to connect said apparatus to a PSTN network (fig. 2), a second port (IP network interface) to connect said apparatus to an IP network (fig. 2), and a gateway means (processor) for establishing a path between said first port and said second port inside said apparatus in response to a request from a server 40 on the IP network acting on behalf a caller (fig 4 col. 9 lines 49-58; noted the internet telephony device, operate in similar ways as ITG 30 in fig. 2, wherein a path is create between the PSTN interface and the IP network interface in response to a request to map a telephone number to an IP address from the AMS 40); and gateway location servers 40 connected to said IP network 19, said gateway location servers 40 being adapted to receive a request from a first telecommunication apparatus 18 connected to said packet IP network 19 for telecommunication with a specified telephone apparatus 14 on said PSTN network 24, and further being programmed to select a second of said telecommunication apparatuses 20 to serve as gateway between said networks for said requested connection, and to forward to said request to said second telecommunication apparatus via IP network (fig. 1 col. 52-65), whereby said telecommunication apparatus can serve as part of a distributed gateway system (a distributed gateway system is defined in the specification on page 18, lines 5-7 as a gateway connecting to both the PBDN and the PSTN) between said circuit switched telecommunication network and said packet based

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telecommunication network (fig. 4; the internet telephony system serve as a distributed gateway system connecting to both the PSTN and IP networks).

Regarding to claims 9, 11, and 12, Schuster discloses SRITG 18/20 includes means for registering with said gateway location servers 40 the availability of said apparatus to act as a gateway between said IP network 19 and said PSTN network 22/24 (fig. 1 col. 9 lines 44-61).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster in view of Chan et al (U.S. Patent 6,711,160 B2).

Regarding to claim 3, Schuster discloses all the limitations with respect to claim 2, except for a mechanism to automatically connect said third port directly to said first port in the event of power failure. However, Chan discloses packet telephone system comprising a fallback switch 110 for connecting a telephone handset 111 (third port) directly to a PSTN interface 112 (first port) in the event of power failure (fig. 1 col. 6 lines 51-64). Thus, it would have been obvious to a person of ordinary skill in the art to employ a fallback switch as taught by Chan in Schuster's system to provide an optional arrangement capable of making telephony connection when the packet network is inactive.

Regarding to claim 7, Schuster discloses the packet based telecommunication network comprises the Internet (fig. 1 col. 4 lines 13-17).

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster in view of Bhattacharya et al (US Patent 6,353,610 B1).

Regarding to claim 10, Schuster discloses all the limitations with respect to claim 9, except for a means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network. However, Bhattacharya discloses an internet telephony system, wherein a source gateway 100 (gateway location server) is notified of an off hook condition when the destination gateway 130 serving between the Internet 125 and the PSTN 145 detects a busy signal (fig. 1 col. 4 lines 52-61). Thus, it would have been obvious to a person of ordinary skill in the art to employ an off hook notification as taught by Bhattacharya in Schuster's system to alert the subscriber of the connection status.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 571-272-3122. The examiner can normally be reached on M-F (9:00 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RICKY NGO  
PRIMARY EXAMINER

5/12/05